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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,460	06/29/2001	Joseph G. Gatto	089070-0311366	7177
909 7590 07/25/2007 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102			EXAMINER SUBRAMANIAN, NARAYANSWAMY	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 07/25/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/893,460

Applicant(s)

GATTO, JOSEPH G.

Examiner

Narayanswamy Subramanian

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/19/2007</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This office action is in response to applicant's request for continued examination of April 18, 2007. Replacement drawings submitted by the applicant on April 18, 2007 have been entered. Claims 1-40 have been examined. The rejections and response to arguments are stated below.

#### **Claim Rejections - 35 USC § 101**

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-39 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1-39 are drawn to "a system for monitoring analysts' estimates comprising: means for storing; means for analyzing and determining when one or more alert conditions are satisfied; and means for issuing an alert". As such the claimed invention does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101, that is a process, machine, manufacture, or composition of matter. The "means for" corresponds to software program elements and not tangible hardware components. Software program elements do not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101.

Claims 1-39 of the disclosed invention are inoperative and therefore lack utility.

Claims 1-39 merely recite elements of an apparatus or a system ("means for" corresponds to software program elements and not tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e. functional descriptive material per se) and therefore is rendered inoperative lacking any utility. Note that a computer (or software program) code cannot by itself perform the underlying function until it is loaded on some computer readable memory and accessed by the computer (or a processor). Functional descriptive material, per se, is not statutory. This is exemplified in *In re Warmerdam* 31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

The dependent claims are rejected for the same reason and by way of dependency on a rejected independent claim.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 1- 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 40 recite the limitation "analyzing the current estimate data and determining when one or more alert conditions are satisfied". However it is not clear as to what is the relationship between the limitation of analyzing and the limitation of determining. It is not

Art Unit: 3692

clear if the determining is performed regardless of the outcome of the analyzing step or if it is performed based on the analyzing step. Hence the scope of the claim is not clear. Claims 2-39 are rejected by dependency on a rejected independent claim. Appropriate clarification/correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frey et al. (US Patent 5,557,513).

Claim 1, Frey discloses a system comprising: means for storing data (See Frey Figure 1, Abstract, Column 4 lines 65-67); means for analyzing the data and determining when one or more alert conditions are satisfied (See Frey Figure 1, Abstract, Column 5 lines 1-9); and means for issuing an alert when at least one predetermined alert condition is satisfied (See Frey Figure 1, Abstract, Column 5 lines 10-17).

Frey does not explicitly disclose data on a per analyst basis, current estimate data for a plurality of analysts, the data including at least an estimate amount and when the estimate was made. However the description of data (data on a per analyst basis, current estimate data for a plurality of analysts, the data including at least an estimate amount and when the estimate was made) is interpreted as a non-functional descriptive material because it does not affect in any

Art Unit: 3692

way the means for storing, analyzing, determining and issuing an alert. Hence the limitation “data on a per analyst basis, current estimate data for a plurality of analysts, the data including at least an estimate amount and when the estimate was made” is not given patentable weight. The prior art structure is capable of performing the intended function and hence it meets the claim.

Claims 2-39, the feature in these claims describe the data further and do not further limit the means for storing, analyzing, determining and issuing an alert. Hence the limitations in these claims are interpreted as non-functional descriptive material and not given patentable weight. The prior art structure is capable of performing these intended functions.

Claim 40, Frey discloses a method comprising the steps of: storing data (See Frey Figure 1, Abstract, Column 4 lines 65-67); analyzing the data and determining when one or more alert conditions are satisfied (See Frey Figure 1, Abstract, Column 5 lines 1-9); and issuing an alert when at least one predetermined alert condition is satisfied (See Frey Figure 1, Abstract, Column 5 lines 10-17).

Frey does not explicitly disclose data on a per analyst basis, current estimate data for a plurality of analysts, the data including at least an estimate amount and when the estimate was made.

Official notice is taken that the feature of data on a per analyst basis, current estimate data for a plurality of analysts, the data including at least an estimate amount and when the estimate was made is old and well known in the art. These estimates help investors stay informed and make informed decisions about their investment portfolio.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Frey to include these features. The combination suggests that investors would have

Art Unit: 3692

benefited from being informed about the current earnings estimate on their investment and it would have helped them make informed decisions about their investment portfolio.

*Response to Arguments*

8. Applicant's arguments with respect to pending claims 1-40 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached at (571) 272-6783. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dr. N. Subramanian  
Primary Examiner  
Art Unit 3692

July 23, 2007